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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,446	11/14/2003	Kenneth A. Walker JR.	03-025	9623
37420	7590	02/27/2006	EXAMINER	
VISTA PRINT USA INC. ATTN: PATENT COUNSEL 100 HAYDEN AVENUE LEXINGTON, MA 02421			WOODS, ERIC V	
			ART UNIT	PAPER NUMBER
			2672	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/713,446	WALKER ET AL	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric Woods	2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,11,13-17 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,11,13-17 and 21-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/09/05 has been entered.

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 11/9/05 was filed after the mailing date of the Final Rejection, but was filed with the RCE on 11/9/05. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Response to Arguments***

Applicant's arguments, see Remarks pages 1-5 and claim amendments, filed 11/9/05, with respect to the rejection(s) of claim(s) 1, 3-7, 11, 13-17, and 21-30 under various statutes and combinations have been fully considered and are persuasive.

Therefore, the rejection of claims 1, 3-7, 11, 13-17, and 21-30 under 35 USC 103(a) has been withdrawn pursuant to applicant's amendments to the claims only.

However, upon further consideration, a new ground(s) of rejection is made in view of various references as below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3-7, 11, 13-17, and 21-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Roses* in view of *Noda* and *Haeberli*.

As to claim 1,

A computer-implemented method for facilitating user customization of the image content of an image area in an electronic product design, the method comprising: (Preamble is not given patentable weight, since it only recites a summary of the claim and/or an intended use, and the process steps and/or apparatus components are capable of standing on their own; see *Rowe v. Dror*, 112 F.3d 473, 42 USPQ2d 1550 (Fed. Cir. 1997), *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999), and the like.) (*Roses* [0068] stating the method is computer-implemented, Fig. 1 clearly shows a document composition website 110 that is connected to a customer photo web site 115 and general web site 120 for obtaining

photos and images for obtaining image content for insertion into a document (see Fig. 2, where the images are put into an image basket) and such documents and their templates are shown in Fig. 5, with an image editing step shown in Fig. 6 with cropping capabilities as shown and in [0037,0043,0048])

-Displaying an electronic product design to a user, the design containing at least one or more user-customizable image areas, each image area having content that is at least a portion of a base image associated with the image area; (Roses shows an electronic document or product design in Fig. 5, with the image areas shown in Fig. 6 and allowing the user to manipulate them – see [0028] for posters, Fig. 10 shows as item 1021 and next to it, that a “Year 2001 Calendar Type” can be chosen as a template, thus illustrating another type of document template, the document creation module / tool of Roses is shown in Fig. 2 as element 206, which is facilitated by the document creation / storage module 306 in Fig. 3 – see [0032-0033], where Roses teaches that documents have areas for fixed images (e.g. images with a fixed size, thus requiring cropping as in Fig. 6). Further, in [0047], it is taught that templates can have modifiable images, e.g. images that can be modified by the user, wherein the fixed images consist of images of a given size for insertion into a block, where in [0048] it is taught that the fixed images are clearly modifiable, since they can be cropped, filter, moved (location), et cetera)(Haeberli clearly teaches a ‘product’ (1:25-35; 2:10-3:20), where the user is presented with the ability to select various types of product, inclusive of ones where the final image placement is dependent upon the user’s cropping of the base image (3:25-4:25, Figure 9b), see also Figures 8A-8B, 13:1-25, where the user can specify product

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orientations and details (diptych), and can put two images in one frame (for example); note also Figures 12a-12b, where the user can change the overall area and print size) ) (User selects the image as input in Noda [0052], and further Noda allows the user to select the inner area where the image will be inserted from a template [0002,0024], and in Figs. 9A-9F where various layouts of photos for albums, etc. are shown. Further, these areas exist and may have a base size [0077-0078], as is known in the art (e.g. L-size, etc.) However, the user can set the size of these areas to a certain extent [0082-0085] by modifying the crop boundaries within the image, and also within Figures 10A-10D various other templates are shown, where the user could for example change the positions of the components of the template)(Blumberg teaches that the use of scalable documents, e.g. the user is allowed to choose the resolution / size, and relative position of an image within a document, for example see the template in Figure 3, where the user requests the portion of an image that is desired [0101], and the selected portion of the image is displayed within the frame of the image in the document (see Figure 4)) -Allowing the user to select an image area for customization of the content of the image area, and (Roses [0047-0048] wherein there are modifiable images in the template that the user can customize, and also the fixed images can be customized by allowing the user to choose the image)(Haeberli clearly teaches that the user can select the desired portion of the window – see cropping window 9b, and also the Abstract. See where it states 'When a user changes the current selected portion of the image (for example, by actuating a control included in the user interface), a new crop mask can be generated based on the changes made by the user'). Clearly, this constitutes customization, and

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comprises' allowing the user to select an image area for customization of the content of image area. Also, note Figures 17a-17b, 14, where the user can change the borders, text, and the like, which would clearly constitute 'allowing the user to select an image area for customization')(User selects the image as input in Noda [0052], and further Noda allows the user to select the inner area where the image will be inserted from a template [0002,0024], and in Figs. 9A-9F where various layouts of photos for albums, etc. are shown, and finally in [0042-0043] it is taught that the user can select and customize the placement of text and images in modifiable areas)

-In response to a user request to perform custom cropping for the selected image area, displaying to the user (Haeberli clearly teaches that the user can elect to perform cropping on the image (see above, Figure 9b, 13:25-14:30), see the toolbar above, where there are options for 'Crop, Rotate, Effects, Borders' and the like)

-The associated base image, and (Roses Fig. 6 and [0043-0044], where the image is displayed in the section 611 for example, and the user can preview the document so in area 602 whilst editing it here)(Haeberli Figure 9b, which shows the base image – that is, the selected portion of the image 904 is shown)(Noda Fig. 3 where the image is displayed in area 46, and the user selects which image to show [0052] in the full size)

-A cropping indicator positioned to indicate to the user the portion of the base image that is the current content of the image area. (Haeberli Figure 9, clearly shows cropped area 904 in Figure 9b, where the cropping indicator is positioned to indicate the area that will be cropped, where the user can (13:25-14:30)

change the shape of the cropping area, move it around, and otherwise alter it to their specification.)(Cropping indicator 84 in Noda Fig. 3 as discussed in [0081] is fit to the selected paper size or template spot)(Blumberg teaches that the user can select the desired portion ([0097-0105]) and that there is a link to the larger version of the image so that the user can see the desired portion and zoom in and out and the like, which results in only the desired portion of the image being shown as Figures 4A-4C)

Applicant invokes means-plus-function language in claim 11. Clearly, the recited means would be equivalent to that of applicant. For example, the customization capabilities of the Roses reference in Figs. 4-7 and as taught in [0042-0043], where templates can be edited and have specific areas and layouts, as does Noda, for example in Figs. 9A-9F, and even more so in Figs. 10A-10D where the user can configure the locations of the various regions that are superimposed, which clearly provides the functionality recited by applicant in the specification and shown in for example Fig. 3. In Fig. 4 of the instant application, where the user can change cropping of an image, the user clearly can make those choices as shown in Fig. 6 of Roses and Figs. 3-5 and 11-13 of Noda, and the user can switch between images as shown with the navigation buttons on the Roses reference in Fig. 3 in the image chooser box, and Noda also allows modification in that manner. Clearly the image modification system of applicant shown in Figs. 5-9 of the instant application corresponds to the system of Noda in Fig. 3, with the manipulable cropping areas and boundaries (see element 84) and further in [0081-0084] Noda



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reveals that the crop boundary may be changed in size so as to correspond to the capabilities of applicant's recited invention. Clearly, both systems are software, and it is well known in the art that any piece of software functionality can easily be implemented on another (same look and feel) in a manner where the functionality is alike yet uses completely different code to do so. As such, the means plus function limitations under 35 U.S.C. 112, sixth paragraph, have been met, and examiner has met the burden to prove a *prima facie* case of equivalence between the recited elements. It is now applicant's responsibility to rebut the premise that applicant's invention and the equivalent functions of Roses and Noda are the same if applicant wishes to do so.

Roses teaches all the limitations of the stated claims, but does not expressly provide for the cropping indicator having the same height-to-width ratio as the selected image area, although since the image can be cropped such that it fits in the template, this is implied. Reference Noda also teaches most of the limitations, and explicitly teaches the use of customizable images and templates, and a manipulable cropping tool. Obviously the references are directed to a similar problem solving area and are analogous art, as both deal with inserting images into document templates and manipulating them.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system of Roses with that of Noda because the system of Noda clearly allows for more effective cropping of images to fit in templates as set forth in the paragraphs above, especially since Roses does not show how the images are cropped per se or if the user is able to expressly choose the desired portion

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of an image to go in the template, and further Noda allows more options as far as customizing images such that when the image customization process is complete, multiple images could be combined into one and put into the documents of Roses (Figs. 4-6) or Noda (Figs. 10A-10D), which would prima facie allow for greater flexibility in how the user can manipulate the documents, as shown in Noda, which is beneficial.

As for the newly added limitations, Haeberli covers those. In the Haeberli patent, the user issues the request for custom cropping and modifies the custom area as desired. Additionally, Haeberli allows the user to undo crops and other image changes to allow the user to customize the image area as desired. Finally, Haeberli teaches the limitation of allowing the user to modify the portion of the base image in the current image area by adapting the cropping indicator to match the shape of the region and the like. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Roses/Noda system to allow cropping of images in an online system for product ordering, since Haeberli allows the user to modify such images and does not "forget about the base image" since the user has uploaded the various images to the Shutterfly website in the first place, which clearly therefore means that they will in residence on the website. The Shutterfly service is expressly provisioned to allow users to create desired end products from basic digital photographs previously uploaded to the website. Motivation is found in 6:10-50, where the user's modification history is stored so that the user can log back into the site and continue modifications as if no time had elapsed, and other similar improvements shown therein.

As to claims 32 and 33, Haeberli clearly teaches a computer-readable medium containing such a program, and a computer system to execute it, in 23:22-24:22 and Figure 19. These are merely notoriously well known variants of means of storing and executing the method of claim 1. Further, the computer system of Haeberli in Figure 19 has a central processor 1921. The other references also teach these limitations.

As to claims 3 and 13, as set forth in the rejection to claim 1, Noda allows the user to change the size, position, and other aspects of the cropping boundary, which is prima facie equivalent to the cropping indicator [0083-0084], clearly this is done relative to the base image, where the base image is shown on the screen and the cropping indicator is altered relative to the base image as desired by the user. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 4 and 14, Noda clearly sets forth in [0082-0083] that the user cannot change the aspect ratio (e.g. the width to height ratio) even though the size can be in certain embodiments. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 5 and 15, the system of Roses allows the user to view the image in the preview window 602 of Fig. 6 when the image has been selected and scaled and/or cropped to fit, or manually filtered – see Fig. 6 and [0043-0044], and so it is updated, and the user can also do so at any time by hitting the preview button. The Blumberg reference further updates the image shown in the document after the user has altered in [0093-0105]. Further, motivation or combination is taken from the rejection to the parent

claim and herein incorporated by reference. Updating an image upon modification in the preview window is also prima facie obvious.

As to claims 6 and 16, the user can prima facie move the crop boundary / indicator around the base image in Noda as taught in [0081] and as shown in Fig. 3 for example. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 7 and 17, the system of Roses allows the user to view the image in the preview window 602 of Fig. 6 when the image has been selected and scaled and/or cropped to fit, or manually filtered, or the cropping window has been repositioned or moved (see Noda [0081—0082]) – see Fig. 6 and [0043-0044], and so it is updated, and the user can also do so at any time by hitting the preview button. Updating an image upon modification in the preview window is also prima facie obvious. Motivation and combination is taken from the parent claim and incorporated by reference herein. Also see the discussion in the rejection to claim 5 above, which is incorporated by reference.

As to claims 21 and 26, the Noda reference very clearly teaches that the user can open a template and that the system can automatically insert an image that is scanned into the first field in the template, which clearly would constitute the recited limitation – e.g. the computer would automatically select the base image associated with the selected image area – see [0051-0057], Noda. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 22 and 27, the Noda reference very clearly teaches that the user can select a thumbnail of an image to put into a template [0051-0057], and clearly in Figure 7 the crop boundary takes the shape and size of the template, but can be altered by the user. In any case, the system of Noda can automatically select a portion of the image to crop and display in the template (e.g. centered crop [0051-10062]), which constitute the user not selecting the portion shown initially in the template as recited in the instant claim. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 23 and 28, obviously Roses allows the user to manipulate the size of the template areas [0037], where their location is independent of each other. Further, Noda teaches that templates (e.g. Figures 10A-10D) may have overlapping images, so very clearly it would be obvious that the various images or portions of the template would be independent of each other since Roses allows the user to control all aspects of the template per se. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 24 and 29, Noda clearly teaches that various templates can be shown to a user to allow the user to select the desired template [0080 specifically, [0078-0082 generally]], and Noda teaches selecting various images via thumbnail in [0055-0057] for example, where it would be obvious that if the user can select from amongst a plurality of visual templates, that thumb nailing the templates would be an obvious expedient to speed the selection process, since Noda does so for images explicitly and implicitly would do so since the plurality of templates would be visible to

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the user to select from, and this modification (if required) would have been obvious.

Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 25 and 30, obviously the user is allowed to select the image that goes into a particular template area [0055-0057 for examples]. It would be obvious that the user could choose another image to put into the image area depending on their tastes and preferences, since the association between images and base areas is preserved and not made permanent until an output document is created, e.g. a photograph album page is printed, and the like. Noda and Roses both allow the user to change the desired image, and further the system of Blumberg will allow the user to specify an image by specifying the path of the image on the remote server, where altering the displayed image would be merely a function of changing the image path. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 31 and 32, Haeberli 1:55-2:6 clearly teaches that online photo shops are available where the user can manipulate the image on the web and then have it printed and mailed to them. Therefore, this is an obvious expedient for the reasons described therein, and constitutes 'forwarding the product design to a printer for printing', where a 'printer' would constitute a printing device at an on-line photo finisher (e.g. the provider of Shutterfly, the Haeberli patent, etc).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric Woods

February 13, 2006



ULKA CHAUHAN  
SUPERVISORY PATENT EXAMINER

ULKA CHAUHAN  
SUPERVISORY PATENT EXAMINER  
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